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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,840	03/21/2005	Noboru Murabayashi	45010-04344	9129

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William S Frommer  
Frommer Lawrence & Haug  
745 Fifth Avenue  
New York, NY 10151

EXAMINER
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DUNN, MISHAWN N

ART UNIT	PAPER NUMBER
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2621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,840	<b>Applicant(s)</b> MURABAYASHI ET AL.	
	<b>Examiner</b> MISHAWN DUNN	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 18, 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-16, 19-26, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/04, 3/05, 2/08, 6/08</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 3, 4, 11-16, 19, 20, 23, 24, 29, and 30 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example the methods including steps of receiving, reading, executing, detecting, reproducing, recording, displaying, generating, moving, adding, setting, classifying, and creating is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 and 21-26 rejected under 35 U.S.C. 102(e) as being anticipated by Dimitrova (US Pat. No. 7,356,830).

5. Consider claim 1. Dimitrova teaches an information-signal process apparatus comprising: characteristic information detection means for detecting information on characteristics of a first information signal to be recorded for each predetermined processing unit of said first information signal; classification process means for classifying segments of said first information signal into segments exhibiting similarity of said characteristics on the basis of a detection result produced by said characteristic information detection means (col. 3, lines 31-42); information-signal generation means for generating a second information signal having an associative relation with said first information signal for said each predetermined processing unit of said first information signal (col. 5, line 54 – col. 6, line 25; fig. 2); identification information creation means for creating information on identifications each used for identifying said second information signal to be used in a tabular display and identifying a display position of said second information signal for each of said classified segments on the basis of a classification result produced by said classification process means (col. 6, lines 26-38; fig. 3); and recording means for recording said first information signal, said second information signal and said information on identifications onto a recording medium (col. 8, lines 52-63; col. 10, lines 4-11).

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6. Consider claim 22. Dimitrova teaches the information-signal process apparatus according to claim 21, further having: selection-input reception means for receiving a selection input of selecting at least one picture according to said second information signal displayed on said display device in a tabular format; and reproduction control means for reproducing said first information signal starting from a position corresponding to said picture selected by said selection input received by said selection-input reception means (col. 7, lines 53-66).

7. Consider claim 25. Dimitrova teaches an information-signal process apparatus for reproducing an information signal recorded onto a recording medium after completing processes of detecting characteristics of said information signal for each predetermined processing unit, classifying segments of said information signal into segments exhibiting similarity of said characteristics on the basis of said detected characteristics and adding identifications for identifying said classified segments to said information signal, said information-signal process apparatus comprising: read means for reading out said information signal recorded on said recording medium; execution-command-input reception means for receiving a command input making a request for execution of a special reproduction process; mode select means for selecting a special reproduction mode from a plurality of special reproduction modes on the basis of information on attributes added to said information signal to be reproduced from said recording medium or on the basis of a command input received from the user upon reception of a command input making a request for execution of a special reproduction process through said execution-command-input reception means; and control means for

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controlling said read means to change a range of said information signal, which is to be read out from said recording medium, in accordance with said special reproduction mode selected by said mode select means (col. 7, line 53 – col. 8, line 33).

8. Claims 2-4, 21, 23, 24 and 26 are rejected using similar reasoning as the corresponding claims above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5, 7, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitrova (US Pat. No. 7,356,830) in view of Nakai (US Pat. No. 5,949,955).

11. Consider claim 5. Dimitrova teaches an information-signal process apparatus comprising: characteristic information detection means for detecting information on characteristics of a first information signal to be recorded for each predetermined processing unit of said first information signal (col. 3, lines 31-42); identification information generation means for generating identification information for identifying a predetermined signal segment of said first information signal on the basis of a detection result produced by said characteristic information detection means (col. 6, lines 11-18; fig. 2).

Dimitrova does not teach a recording means for recording said first information signal in a first recording area of a recording medium and a second information signal in a second recording area of said recording medium wherein: said first and second recording areas are set in accordance with a recording method determined in advance for said recording medium; and said second information signal is an information signal included in said first information signal as an information signal in said predetermined signal segment identified by said identification information.

However, Nakai teaches a recording means for recording said first information signal in a first recording area of a recording medium and a second information signal in a second recording area of said recording medium wherein: said first and second recording areas are set in accordance with a recording method determined in advance for said recording medium; and said second information signal is an information signal included in said first information signal as an information signal in said predetermined signal segment identified by said identification information (col. 1, line 63 – col. 2, line 9).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to record said first information signal in a first recording area of a recording medium and a second information signal in a second recording area of said recording medium wherein: said first and second recording areas are set in accordance with a recording method determined in advance for said recording medium; and said second information signal is an information signal included in said first information signal as an information signal in said predetermined signal segment

identified by said identification information, in order to allow users to easily select the data recorded on the recording medium.

12. Consider claim 7. Nakai teaches the information-signal process apparatus according to claim 5 wherein said recording means provides said first recording area for recording only one piece of said first information signal and said second recording area for recording only one piece of said second information signal, and records said piece of said first information signal and said piece of said second information signal in said first and second recording areas, respectively (col. 1, line 63 – col. 2, line 9).

13. Claims 11 and 13 are rejected using similar reasoning as the corresponding claims above.

14. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitrova (US Pat. No. 7,356,830) in view of Nakai (US Pat. No. 5,949,955) in further view of Official Notice.

15. Consider claim 6. Dimitrova and Nakai teach all claimed limitations as stated above, except wherein said recording means records a plurality of said first information signals in said first recording area having a variable storage size for accommodating said first information signals as a cluster of said first information signals and a plurality of said second information signals in said second recording area having a variable storage size for accommodating said second information signals as a cluster of said second information signals.



However, the examiner takes official notice that it is well known in the art to have variable storage sizes on an optical medium.

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to record a plurality of said first information signals in said first recording area having a variable storage size for accommodating said first information signals as a cluster of said first information signals and a plurality of said second information signals in said second recording area having a variable storage size for accommodating said second information signals as a cluster of said second information signals, in order to minimize the generation of dead space.

16. Claim 12 is rejected using similar reasoning as the corresponding claim above.

***Allowable Subject Matter***

17. Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Claims 17, 18, 27, and 28 are allowed.

19. The following is a statement of reasons for the indication of allowable subject matter: The present invention is directed towards a recording/reproduction apparatus capable of making use of a large-quantity information signal recorded onto a recording medium. Independent claims 17 and 18 identify the uniquely distinct features, "second recording means for moving only one or more said first information signals from said first recording medium to a second recording medium in case a detection result

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produced by said storage-size detection means indicates that the storage size of a free area left in said recording medium is smaller than a predetermined value. Independent claims 27 and 28 identify the uniquely distinct features, "wherein said portions reproduced from said recording medium each have a length equal to a predetermined set segment length and are separated from each other by a predetermined interval segment length." The closest prior art does not anticipate or render the above obvious.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISHAWN DUNN whose telephone number is (571)272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MISHAWN DUNN/  
Examiner, Art Unit 2621  
January 8, 2009

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621